

## **REMARKS**

### **Status of the Claims**

Claims 2-4 and 9-11 are pending in the present application. Claim 5 is withdrawn from further consideration due to a restriction requirement. Claims 1, 5 and 8 are canceled, and new claim 11 has been added. Reconsideration and allowance of all of the pending claims is respectfully requested.

This amendment does not add new matter to the application as filed. New claim 11 is supported by original claim 7, now written in independent form, and containing limitations previously presented in claim 1. Accordingly, no new matter is added and entry of this amendment is respectfully requested.

### **Claim Rejections - 35 U.S.C. §102**

Claims 1-4 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by each of Uphues '082 (US 5,442,082), Miyauchi '135 (US 5,801,135), Irinatsu '957 (US 6,179,957), Hamaguchi '949 (US Patent 4,964,949), Irinatsu '056 (US 6,103,056), Ikeda '708 6,565,708), or Takahashi '244 (US 5,672,244).

Claims 1-4 and 8-10 also stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tadokoro '392 (US 6,599,392).

Applicants respectfully traverse each of these rejections for the following reasons.

#### ***1. Legal Standard for Determining Anticipation***

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore "[T]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that each and every element of the present claims is not disclosed by the prior art. In particular, the prior art does not disclose or suggest a process of preparing a deinking agent which does not use fats and/or oils. See claim 9. Accordingly a proper case of anticipation has not been made out and the pending rejections must be withdrawn.

## *2. The Present Invention*

The present invention is directed to process for preparing a deinking agent which comprises esterifying an alkylene oxide adduct to a polyhydric alcohol, having a valency of 3-10, with a carboxylic acid. In particular, the prior art does not disclose or suggest a process of preparing a deinking agent in the absence of fats and/or oils as recited in claim 9. Accordingly, all of the limitations of the present claims are not disclosed by the prior art and the pending prior art rejections must be withdrawn.

## *3. Distinctions Between the Present Invention and the Prior Art*

Uphues '082 does not disclose the process of the present claims. Uphues '082 expressly discloses that the use of fats and/or oils is included in the disclosed method. See column 3, lines 12-15. In fact, in each one of the Examples of Uphues '082 soybean oil is used. See col. 4, line 24; col. 4, line 42; and col. 4, line 52.

The Examiner asserts at page 2, paragraph 5, of the Office Action that Uphues '082 discloses fatty acids and not oils. However, Applicants note that Examples 1 and 2 of Uphues

'082 actually disclose an epoxidized soybean oil, and not soybean oil fatty acid. In Example 3 Uphues '082 discloses an epoxidized soybean oil fatty acid 2-ethyl hexylester. Nevertheless, such soybean oil fatty acids are mixed with glycerin, and then an alkylene oxide is added to the mixture. That is quite different from the present methods which involve esterifying an alkylene oxide adduct to a polyhydric alcohol with a valency of 3-10 with a carboxylic acid.

The Examiner also quotes Miyauchi '135 as describing an alkylene oxide adduct to a fatty acid. However applicants respectfully note that Miyauchi '135 does not disclose an alkylene oxide adduct to a polyhydric alcohol having a valency of 3-10 as presently claimed.

Miyauchi '135 also expressly discloses only the use of a mixture of a polyvalent alcohol and fats and/or oils. See Miyauchi '135, col. 3, lines 32-35. Similarly Hamaguchi '949 only discloses the use of a mixture of a polyvalent alcohol and fats and/or oils. See col. 2, lines 1-5. Takahashi '244 also describes alkylene oxide adducts to fats and /or oils. See col. 2, lines 36-39.

In Tadokoro '392 the ester compound of the paper bulking promoter shows in column 1, lines 60-63, that alkylene oxide adducts to an ester of polyvalent alcohol and fatty acid are obtained. Therefore, a known esterification and a known alkylene oxide addition reaction are utilized. There is no mention in Tadokoro '392 that the esterification is carried out after the addition of the alkylene oxide to the alcohol.

In Irinatsu '957 a non-ionic surfactant, which is utilized in the reaction process, is disclosed to be an alkylene oxide adduct of a mixture of an oil and fat and a mono- or polyhydric alcohol. See column 4, lines 52-56. Irinatsu '056 also discloses methods which use an alkylene oxide adduct of a mixture of an oil and fat and a mono- or polyhydric alcohol. See column 5, lines 12-15.

Accordingly, Applicants respectfully assert that each and every element of the present claims are not disclosed by the asserted prior art, and the pending rejections must be withdrawn. An early reconsideration and Notice of Allowance are respectfully requested.

**Conclusion**

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark Konieczny (Reg. No. 47,715) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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